

Application No. : 10/665,213
Art Unit : 3744

Attorney Docket No. 22461.00
Confirmation No. 5730

REMARKS

By the present amendment, Applicant has canceled Claims 1-6 and 11-14, amended Claims 15 and 18-20, and added Claims 21-22. Claims 7-10 and 16-17 were canceled by the previous amendment. Claims 15 and 18-22 remain pending in the present application. Claim 15 is the sole independent claim.

In the recent Office Action the Examiner rejected Claims 1, 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Carter et al. (U.S. Patent No. 6,382,469) in view of Trachtenberg (U.S. Patent No. 6,446,453). Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter et al. in view of Trachtenberg, and further in view of Goncalves (U.S. Patent No. 4,513,890) or Gross (U.S. Patent No. 6,269,986). Claims 6, 11-15 and 18-20 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Carter et al. in view of Trachtenberg, and further in view of Goncalves or Gross.

The cancellation of Claims 1-6 and 11-14 by the present amendment renders the prior art rejection moot with respect to these particular claims. With regard to the remaining claims, Applicant will advance arguments herein below to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

Independent Claim 15, as amended, is specifically directed towards a vehicle refrigerant canister with an extension for delivering pressurized refrigerant within the canister to an air conditioning unit of a vehicle. The claimed canister includes, in part, an actuator cap having a threaded projection extending therefrom and a refrigerant charging hose removably secured to the threaded projection for delivering the released refrigerant to the air conditioning unit of the vehicle. Applicant's invention provides a convenient means for adding refrigerant to an auto air conditioning unit and eliminates the use of a shutoff valve, which is cumbersome and time-consuming to connect to conventional refrigerant canisters.

In contrast, the primary reference to Carter et al. (U.S. 6,382,469) is directed to a tire inflation actuator having a discharge tube attached thereto. While this reference discloses that the actuator may be used with containers having other than air contents, "such as freon for recharging and other aerosol dispensing application," there appears no realistic disclosure of how the reference container could be modified to recharge air conditioning units in vehicles. Without the benefit of Applicant's own disclosure, one of ordinary skill in the art would not realistically be taught by this nebulous disclosure exactly how this could be accomplished. This is particularly true since the use of freon as a refrigerant in servicing auto air conditioning units was banned by the end of 1995, well before the filing date of the Carter et al. patent. Clearly, there appears no suggestion in Carter et al. that the discharge tube may be removable and re-used with new pressurized containers as set forth by the present claims.

The Examiner relies upon the secondary references to Trachtenberg to teach a threaded connector at one end of a refrigerant line. The Examiner thus concludes that it would be obvious to one of ordinary skill in the art to provide the actuator of Carter et al. with the threaded connector as taught by Trachtenberg. Notwithstanding the Examiner's conclusion of obviousness, it is apparent that the patent to Carter et al. is concerned with a tire inflation actuator that is "capable of being easily manufactured without complex assembly of various components." This reference further states the one-piece integrally molded actuator is "simply mounted on the container 12 after assembly with the discharge tube 24." See Col. 9, lines 53-61. Clearly, one skilled in the art would not be motivated or guided by the prior art to substitute the threaded connector taught by Trachtenberg for the discharge tube of Carter et al. since such a modified construction would defeat the expressed intentions of the primary reference in terms of increased costs of manufacture. Further, the Examiner's reliance upon the Goncalves or Gross references fails to supplement the apparent deficiencies of the combined teachings afforded by Carter et al. and Trachtenberg.

Applicant notes that obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987). Further, the Federal Circuit in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) deprecated rejections based upon

Application No. : 10/665,213
Art Unit : 3744

Attorney Docket No. 22461.00
Confirmation No. 5730

"a hindsight-based obviousness analysis" and emphasized that what is required is a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The Court said that "the showing must be clear and particular" and that broad conclusory statements regarding the teaching of multiple references and "a mere discussion of the ways that the multiple prior art references can be combined to read on the claimed invention" is inadequate. Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific...findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis".

Applicant contends that one skilled in the art would not be motivated to combine the references in the manner suggested by the Examiner. Applicant further contends that even if the references were properly combinable, the above noted deficiencies of the primary reference to Carter et al. are not remedied by the teachings afforded by the secondary references. Thus, one of ordinary skill in the art without the benefit of Applicant's own disclosure would not be capable of arriving at the presently claimed invention by combining the references in the manner suggested by the Examiner since none of references cited or applied of record realistically suggests the essential combination of features that forms the basis of the instant claims.. For at least these reasons, Applicant respectfully submits that independent Claim 15, as amended, and corresponding dependent Claims 18-22 are allowable over

Application No. : 10/665,213
Art Unit : 3744

Attorney Docket No. 22461.00
Confirmation No. 5730

the prior art of record.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



Dolph H. Torrence
Registration No. 34,501
(703) 486-1000

DHT:RCL

Attachments: Petition for Extension of Time
Check in the amount of \$510.00